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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/945,342	08/31/2001	Grace Li	4316/19	1433
7590 12/01/2003				
GOTTLIEB, RACKMAN & REISMAN, P.C. COUNSELORS AT LAW 270 MADISON AVENUE NEW YORK, NY 10016-0601			EXAMINER BOYD, JENNIFER A	
			ART UNIT 1771	PAPER NUMBER

DATE MAILED: 12/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/945,342

Applicant(s)

LI ET AL.

Examiner

Jennifer A Boyd

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 14 and 16 - 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 - 14 and 16 - 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The Applicant's Amendments and Accompanying Remarks, filed September 17, 2003, have been entered and have been carefully considered. Claim 15 is cancelled, claim 16 is amended and claims 1 – 14 and 16 – 18 are pending. In view of Applicant's cancellation of claim 15, the Examiner withdraws the claim objection as detailed in paragraph 1 of the previous Office Action dated April 4, 2003. In view of Applicant's Arguments, the Examiner withdraws In view of the Applicant's Arguments, the Examiner withdraws all of the previously set forth 35 U.S.C. 102(b) and 35 U.S.C. 103(a) rejections as detailed in paragraphs 2 – 7 of the previous Office Action dated April 4, 2003. However, after an updated search, additional art was found which renders the invention as currently claimed unpatentable for reasons herein below.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 1 – 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 2 – 8 are rejected as being dependent on a rejected claim.

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5. Claim 1 of Applicant's Amendments, filed September 17, 2003, is different than claim 1 that appears in the marked-up copy in Appendix A of Applicant's Response, filed September 17, 2003. Claim 1 in Appendix A has the additional phrase "and no additional" at the end of the claim. For the purposes of examination at this time, the Examiner will assume that the addition of the phrase "and no additional" was inadvertent and the Examiner will not give weight to that phrase.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1 – 4, 8 - 12 and 17 - 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Forbes et al. (US 6,491,933).

Forbes is directed to an absorbent pouch (Title).

As to claims 1 and 9, Forbes teaches a continuous chain of connected absorbent pouches comprising a first panel, a second panel and a super-absorbent material (Abstract). The first and the second panel are attached along their respective general peripheries so as to form a space therebetween and the space therebetween comprises a super-absorbent material (Abstract). In one embodiment, Forbes teaches that the pouch comprises a first panel made from an impermeable material and a second panel having a large plurality of pore perforations (column 5,

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lines 29 – 36). The Examiner equates the first panel to Applicant's "liquid impermeable back sheet" and the second panel to Applicant's "liquid permeable top sheet". Forbes teaches that the super-absorbent material may be adhered with an adhesive to the first panel, or "liquid impermeable back sheet", **and/or** the second panel, or "liquid permeable top sheet" (column 5, lines 10 – 15). Forbes notes that the space between the two panels is absent of tissue paper, fibrous material and other material (column 5, lines 1 – 10); the super-absorbent material is the only material in the space unless adhesive is used. Forbes teaches that the manufacturing process may result in the continuous chain of connected absorbent pouches being wound in a roll (column 7, lines 55 – 60). As to claim 9, it should be noted that the Examiner considers the phrase "selectively separable from one another" to be a "capable of" type limitation. It has been held that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Forbes teaches that the chain of connected absorbent pouches is severed at selected lengths (column 8, lines 1 – 5).

As to claim 2 and 10, Forbes teaches that the second panel, or "liquid permeable top sheet", can be made from a variety of materials including open-celled foams, perforated films, woven and nonwoven materials (column 3, lines 15 – 20).

As to claims 3 and 11, Forbes teaches that the first panel, or "liquid impermeable back sheet", can be made from a variety of materials including liquid impermeable films such as those made from polyethylene or polypropylene (column 3, lines 27 – 39).

As to claims 4 and 12, Forbes teaches that the super-absorbent material may be crosslinked polyacrylates, such as FAVOR-PACTM 100 (column 4, lines 43 – 50).

As to claims 8 and 18, Forbes teaches that the pouch has a thickness of generally 5 to about 200 mil (0.005 – 0.2 inches) (column 6, lines 52 – 55).

As to claim 17, it should be noted that the Examiner considers the phrase “selectively separable from one another along a traverse score line” to be a “capable of” type limitation. It has been held that an element is “capable of” performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Forbes teaches that the chain of connected absorbent pouches is severed at selected lengths (column 8, lines 1 – 5).

Claim Rejections - 35 USC § 103

8. Claims 5 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Forbes et al. (US 6,491,933) in view of McKinney et al. (US 5,433,994).

Forbes teaches the claimed invention above except for that the super absorbent polymer can be acidic.

McKinney discloses a super absorbent structure with a permeable covering, super absorbent particles and impermeable adhesive layer (column 1, lines 50 – 67). The super absorbent particles suitable for the application include starch modified polyacrylic acids (column 2, lines 50 – 60).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the conventional acidic super absorbent particle of McKinney in the product of Forbes motivated by the desire to use a widely available super absorbent particle which is chemically compatible with the absorbent product.

9. Claims 6 – 7, 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Forbes et al. (US 6,491,933) in view of Ahmed et al. (US 6,534,572).

Forbes teaches that the super-absorbent material may be adhered to the first and/or second panel with an adhesive.

Forbes fails to disclose that the adhesive is selected from the group consisting of organic adhesives, vegetable adhesives and synthetic adhesives as required by claims 6 and 14. Forbes fails to teach that the synthetic adhesive is selected from the group consisting of thermosetting adhesives, thermoplastic adhesives and elastomeric adhesives as required by claims 7 and 16.

Ahmed et al. is directed to a composition comprising a thermoplastic component and at least one superabsorbent component useful for disposable absorbent articles (Abstract). Ahmed teaches that the thermoplastic component may be a hot melt adhesive comprising a thermoplastic polymer (column 5, lines 45 – 50). It should be noted that a thermoplastic hot melt adhesive is a synthetic adhesive. Ahmed notes that the presence of a thermoplastic component actually enhances the performance of the superabsorbent polymer, particularly for reducing unintended gel blocking (column 3, lines 40 – 45).

It would have been obvious and necessary for one of ordinary skill in the art practicing the invention of Forbes to provide the details of the adhesive. As the use of thermoplastic adhesives enhances the performance of superabsorbent polymers by reducing gel blocking in absorbent composites, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the thermoplastic hot melt adhesive of Ahmed in the invention of Forbes, motivated by the expectation of successfully practicing the invention of Forbes.

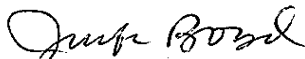
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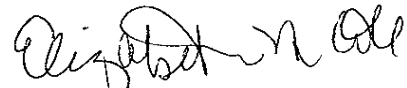
10. Applicant's arguments with respect to claims 1 – 14 and 16 - 18 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer A Boyd whose telephone number is 703-305-7082. The examiner can normally be reached on Monday thru Friday (8:30am - 6:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 703-308-2414. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


Jennifer Boyd
November 19, 2003


ELIZABETH M. COLE
PRIMARY EXAMINER